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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,622

08/24/2006

Kenneth E. Irwin JR.

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EXAMINER

D AGOSTINO, PAUL ANTHONY

ART UNIT

PAPER NUMBER

3714

MAIL DATE

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09/10/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/590,622	Applicant(s) IRWIN ET AL.	
	Examiner Paul A. D'Agostino	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-11 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-11 and 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/24/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This responds to Applicant's Arguments/Remarks filed 03/13/2009. Claims 3-5, 12, and 18-20 have been cancelled. Claims 1-2, 6-11, and 13-17 are now pending in the application.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/13/2009 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-2, 6-11, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,949,042 to Dietz, II et Al. (Dietz) in view of U.S. Patent No. 5,893,797 to Marino et al. (Marino).

Dietz discloses a {lottery} game apparatus (Fig. 2 “electronic validator machine” 30 and Fig. 4) for play of an instant lottery game {plurality of different lottery games by a plurality of different users} (Figs. 1A and 1B and “multiple play gaming ticket” Col. 2 Lines 23-24 and Fig. 6), comprising:

an {plurality of} electronic game device{s} (Fig. 2) each one including a computer (Fig. 4 “microprocessor” 90), a display operatively connected to said computer (Fig. 4 “video monitor” 50), a game card interface operatively connected to said computer (“Pull Tab Acceptor Mechanism” 72), and at least one instant lottery game programmed in said computer (“Play All” feature Col. 8 Lines 51-62 wherein the validator 30 “acts alone

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or in conjunction with a host computer 100, it is preferred that the validator 30 store in its RAM 94 various information about game play” Col. 8 Lines 29-50 wherein the multiple games of pull tab 10 game ticket is played Col. 4 Lines 59-67 and Col. 5 Lines 1-42 such that the game card “effectuates the results of game play” Col. 4 Line 63; With regards to the plurality limitation of Claim 11, Dietz discloses a “host computer” 100 (Fig. 4) impliedly disclosing of a network capable of interfacing with more than one electronic game device each playing a pull tab lottery ticket containing a plurality of games (Fig. 1A “20 plays”));

a game card including game information stored thereon (Figs. 1A and 1B), said game card representing a single lottery game play (Figs. 1 A and 1B displays at least a single game play), said game card adapted for connection with said interface wherein connection of said game card to said interface permits a player to initiate play of said game (Fig. 6 steps 106-116), said game card comprising game information required by the lottery game programmed in said computer to initiate and complete a single play of the lottery game (Fig. 6 steps 112-124) wherein the display and outcome of the lottery game is presented to the player via said display (Fig. 6 step 120) and only after connecting said game card with said game card interface (Fig. 6 steps 106-116);

wherein predetermined outcomes are prize amounts (Fig. 3A “Winnings on Play” and Fig. 6 Step 122 “Accumulate Remaining Plays Winnings”);

wherein said card additionally includes a barcode including data functionally related to said information (“unique bar code” 27 Col. 4 Lines 48-58; Col. 6 Lines 67 and Col. 7 Lines 1-4);

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wherein said interface is configured to permit a player to insert said cards into said device and to make an electrical connection between said data and said computer (Figs. 4 and 6);

wherein said game information on said game card is contained in printed conductive elements ("metallic ink" Col. 7 Lines 5-14);

wherein said predetermined game outcome is represented by one or more impedances (reasonably interpreted in light of the specification to mean that the information imparts a characteristic resistance) printed in said conductive ink and said computer is effective to determine the electronic signature of said impedances when said game card is connected to said interface wherein said electronic signatures are a measure of the resistance of said impedances. (Dietz discloses that "the validation code 24 could be printed on the pull tab card 10 with a metallic ink and then sensed with a validation code 78 reader" Col. 7 Lines 5-15; thus the printing delivers characteristic impedances (resistances) interpretable into information from these electronic signatures. Dietz also discloses that the validation codes are indicative of the game outcomes hence their need for fraud protection);

wherein said computer applies power to said circuit elements through said interface and determines said data from the electrical signatures of said circuit elements (Dietz discloses upon the application of power code is sensed with validation code reader 78 to ascertain the signature of the metallic ink (Col. 5 Lines 1-7 and Col. 7 Lines 5-15));

wherein said device includes a switch (Fig. 4 "Lamps And Button Panel")

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operatively connected to said computer (Fig. 4) and aligned with a predetermined position on said cards wherein said switch is effective to permit a player to play said game (Fig. 2 for example, switch "Play One" 44 will allow player to play one game); and wherein the outcome of said game is predetermined solely by said information on said game card ("pull tabs 10 are legitimate and effectuate the results of game play" Col. 4 Lines 59-67 and Col. 5 Lines 1-8; also, Col. 7 Lines 5-14) and displayed on said display (Fig. 6 step 120) and is not known by the player until played on said electronic game device and is not changed by any subsequent play of the game with said electronic game device (these negative limitations are inherent in traditional scratch tickets and therefore do not further limit the claim; however, Dietz discloses pull tabs the results of which are not known to the player and that remain unchanged once revealed to the player (Fig. 6 and reference to unopened pull tabs requiring x-ray to be validated Col. 7 Lines 1-14, see also Col. 1 Lines).

However, Dietz fails to disclose an apparatus which is handheld and wherein said cards include a scratch-off coating applied over at least a portion of said conductive elements wherein removal of said scratch-off coating by a player alters said conductive elements .

Marino teaches of a hand-held multi-function electronic lottery device (Title) wherein lottery tickets are inserted and outcomes determined electronically in a portable device (Figs. 1-3) in order to provide a hand-held lottery device that is "simple to use" 12-14) in part that it is as portable as the lottery ticket itself.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the hand-held feature as taught by Marino into the teachings of Dietz in order to provide a lottery device that is "simple to use" 12-14) in part that it is as portable as the lottery ticket itself.

Alternatively, Dietz discloses the claimed invention except for it being hand-held. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the lottery validator hand-held, since it has been held that making an old device portable or movable without producing any new and unexpected result involves only routine skill in the art. In re Lindberg, 93 USPQ 23 (CCPA 1952).

In reference to Claim 17, wherein said cards include a scratch-off coating applied over at least a portion of said conductive elements wherein removal of said scratch-off coating by a player alters said conductive elements. Dietz discloses known scratch off gum-like material which can be rubbed off (Col. 1 Lines 35-41) with the edge of a coin or a fingernail. The removal of the material broadly interpreted alters the conductive elements because now they are exposed. Alternatively, some conductive material may be removed with the mechanical removal by the coin edge or the finger nail and as such alters the amount of the conductive material.

Response to Arguments

6. Applicant's arguments with respect to claims 1-2, 6-11, and 13-17 have been considered but are moot in view of the new ground(s) of rejection. Applicant stressed the point that the prior art in the previous Office Action was not related to Applicant's

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claimed invention. Examiner responds by sharing new prior art which he believes addresses Applicant's concerns wherein no player interaction decides the victor and may potentially result in a stronger patent.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is provided in the Notice of References Cited.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is (571)270-1992. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m..

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Supervisory Patent Examiner, Art Unit 3714

/Paul A. D'Agostino/
Examiner, Art Unit 3714